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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/767,244	01/27/2004	Gary W. King	11738.00215	4773

22908 7590 12/20/2006  
BANNER & WITCOFF, LTD.  
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CHICAGO, IL 60606

EXAMINER
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EVANISKO, GEORGE ROBERT

ART UNIT	PAPER NUMBER
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3762

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	12/20/2006	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

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<b>Office Action Summary</b>	<b>Application No.</b> 10/767,244	<b>Applicant(s)</b> KING ET AL.	
	<b>Examiner</b> George R. Evanisko	<b>Art Unit</b> 3762	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 12/6/06.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date: _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                        | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date: _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 12/6/06 has been entered.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 1-9, 11, and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sickmeyer (5846196) in view of Avitall (5702438). Sickmeyer discloses the claimed invention having an extendable span paddle member (e.g. 33/34/43/44, etc) having therapy elements and

the member contracting and expanding by a series of connecting elements/struts (e.g. 35/36/41/42). Sickmeyer also discloses a sheath, 46, that surrounds the paddle and acts as a locking mechanism since the struts/links are restricted by the sheath and since the sheath does not allow the struts to extend. Sickmeyer also allows the sheath to be removed since nothing prevents it from being removed. In addition, elements 45 and 47 are used to adjust the relative positions of first and second points. For claim 11, the span “folds” (i.e. from an extended position to a closed position) when the extendable member expands and contracts. In the alternative for some of the claims, see the 103 rejection below

But Sickmeyer does not disclose the linkage assembly with a series of struts (4 struts) directly pivotally linked to one another at a first and second point to move toward one another to contract the extendable member and away to expand the extendable member. Avitall teaches a linkage assembly with a series of struts (4 struts) directly pivotally linked to one another at a first and second point to move toward one another to contract the extendable member and away to expand the extendable member for easily controlling, deploying, contracting, and expanding the separation of the electrodes and lead (e.g. col 3, line 20). For example, Avitall shows in figures 4-6 the connecting elements/struts, 38b and at 37, being directly connected at a first point/link at reference numeral 34 (and the two struts directly opposite 38b and 37 on the other side of the midline of the lead). It is noted that sheath 18 can be withdrawn and or other catheters can be sequentially employed (column 6, lines 60-65) and that the sheath(s) functions as the locking mechanism compressed over the struts/links since the struts/links are restricted by the sheath and since the sheath does not allow the struts to extend. In addition, a control element or wire is used to expand the lead (column 6, line 43, column 7, lines 25-28 and figures 4-6) and a tether 38a or

38c is used to limit the maximum extent of the expandable member. For claim 11, the span “folds” (i.e. from an extended position to a closed position) when the extendable member expand and contract.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to include in the lead of Sickmeyer, the linkage assembly with a series of struts (4 struts) directly pivotally linked to one another at a first and second point to move toward one another to contract the extendable member and away to expand the extendable member as taught by Avitall, since such a modification would provide a lead with a linkage assembly with a series of struts (4 struts) directly pivotally linked to one another at a first and second point to move toward one another to contract the extendable member and away to expand the extendable member for easily controlling, deploying, contracting, and expanding the separation of the electrodes and lead.

Claims 4, 5, 7, and 10 are rejected under 35 U.S.C. 103(a) as obvious over Sickmeyer in view of Avitall as applied to claims 3, 6, and 1 above. Avitall shows the tether at element 38a or 38c and corresponding element directly opposite of elements 38a and 38c.

Sickmeyer in view of Avitall discloses the claimed invention except for the removable sheath, the locking mechanism, and in the alternative, the tether between the first and second points. It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the lead as taught by Sickmeyer in view of Avitall, with the removable sheath, the locking mechanism, and the tether between the first and second points since it was known in the art that extendable leads use: a removable sheath to allow the user to safely introduce the lead into the patient and remove the sheath to more freely move/use the lead;

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a locking mechanism to secure the lead in the sheath while placing the lead in the body so the lead does not damage internal tissue of the patient; and a tether between points to limit how much the extendable member can expand so that the lead maintains its proper shape and/or does not damage tissue.

### ***Response to Arguments***

Applicant's arguments with respect to the claims have been considered but are moot in view of the new ground(s) of rejection necessitated by amendment.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to George R. Evanisko whose telephone number is 571 272 4945.

The examiner can normally be reached on M-F 6:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Angela Sykes can be reached on 571 272 4955. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

George R Evanisko  
Primary Examiner  
Art Unit 3762

GRE  
12/8/06

12/8/06